

PATENT
App. Ser. No.: 09/853,957
Att. Dkt. No. ROC920000310US1
PS Ref. No.: IBM/2K/0310

REMARKS

This is intended as a full and complete response to the Office Action dated October 20, 2005, having a shortened statutory period for response set to expire on January 20, 2006. Please reconsider the claims pending in the application for reasons discussed below.

Claim Rejections - 35 U.S.C. § 112

Claims 1-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has amended the claims to distinctly claim some aspects of that which Applicant regards as the invention.

Claim Rejections - 35 U.S.C. § 102

Claims 1-2 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by *Aaker et al.*, US. Patent 5,758,087 (hereinafter *Aaker*). Applicant respectfully traverses this rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

In this case, *Aaker* does not disclose "each and every element as set forth in" claim 1. For example, *Aaker* does not teach, as the Examiner admits, predicting the client command at the client computer based on the portion of the client command, determining, at the client computer, whether the complete client command matches the client's predicted command and, if not, sending the complete client command in its entirety along with a flag indicating an unsuccessful prediction from the client computer to the server computer.

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In page 6 of the Office Action, the Examiner admits *Aaker* does not teach predicting the command at the client. However, in making a 103(a) argument, the Examiner submits it would have been obvious to one of ordinary skill in the art to do so in order to reduce network traffic. Applicant submits, however, that this submission is completely unsupported and that there is no obvious certainty that predicting commands at the client would reduce network traffic. The Examiner also states that:

it is inherent that if the method of predicting the client command is performed at the client computer, it is inherent that if client command does not match, the client command must be sent in its entirety along with a flag indicating an unsuccessful prediction from the client computer to the server computer

Again, Applicant submits that this statement is unsupported and that, in fact, if the client command does not match (a local prediction), the command must be sent, but it is not necessary to indicate to the server that the prediction was unsuccessful. Rather, the client could merely wait for the results from executing the entire command at the server.

Therefore, withdrawal of this rejection is rejected. The claims are believed to be allowable, and allowance of the claims is respectfully requested.

Claim Rejections - 35 U.S.C. § 103

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Aaker*.

Claims 4, 8, 11-14, 16-19, 21, 23-25, 28-29 and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Aaker* in view of *Luick*, U.S. Patent 6,230,260.

Claims 9-10, 15, 26-27 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Aaker* and *Luick* in view of *Yashiro et al.*, U.S. Patent 5,787,460 (hereinafter *Yashiro*).

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Aaker* in view of *Brye*, U.S. Patent 6,718,322.

Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Aaker* and *Luick* in view of *Brye*.

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The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2142. To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP § 2143.

The present rejections fail to establish at least the third criterion. For example, none of the references cited teach predicting a command at a client, as claimed, or sending an indication to a server of such a prediction being unsuccessful.

Therefore, the claims are believed to be allowable, and allowance of the claims is respectfully requested.

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Conclusion

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to the Applicant's disclosure than the primary references cited in the office action. Therefore, Applicant believes that a detailed discussion of the secondary references is not necessary for a full and complete response to this office action.

Having addressed all issues set out in the office action, Applicant respectfully submits that the claims are in condition for allowance and respectfully requests that the claims be allowed.

Respectfully submitted, and
S-signed pursuant to 37 CFR 1.4,

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